



Docket No.: 02-0011 (8470-000060) (PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Steve G. Koch

Application No.: 10/790916

Filed: March 2, 2004

Art Unit: 3679

For: Seal Feature To Prevent Bending

Examiner: V. A. Patel

APPEAL BRIEF

MS Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

As required under § 41.37(a), this brief is filed within two months of the Notice of Appeal filed in this case on September 14, 2005, and is in furtherance of said Notice of Appeal.

The fees required under § 41.20(b)(2) are dealt with in the accompanying TRANSMITTAL OF APPEAL BRIEF.

This brief contains items under the following headings as required by 37 C.F.R. § 41.37 and M.P.E.P. § 1206:

- I. Real Party In Interest
- II. Related Appeals and Interferences
- III. Status of Claims
- IV. Status of Amendments
- V. Summary of Claimed Subject Matter
- VI. Grounds of Rejection to be Reviewed on Appeal
- VII. Argument
- VIII. Claims
- IX. Evidence
- X. Related Proceedings
- Appendix A Claims

I. REAL PARTY IN INTEREST

The real party in interest for this appeal is:

Freudenberg-NOK General Partnership

II. RELATED APPEALS, INTERFERENCES, AND JUDICIAL PROCEEDINGS

There are no other appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in this appeal.

III. STATUS OF CLAIMS

A. Total Number of Claims in Application

There are 10 claims pending in application.

B. Current Status of Claims

1. Claims canceled: none
2. Claims withdrawn from consideration but not canceled: none
3. Claims pending: 1-10
4. Claims allowed: none
5. Claims rejected: 1-10

C. Claims On Appeal

The claims on appeal are claims 1-10

IV. STATUS OF AMENDMENTS

All amendments in the present application have been entered. Accordingly, the claims enclosed herein as Appendix A incorporate all of the amendments to claims 1-10.

V. SUMMARY OF CLAIMED SUBJECT MATTER

The claimed subject matter is directed to a gasket (item 20; Figs. 1, 2; paras. [0020]-[0022]) comprising a first generally planar portion (item 22; Figs. 1,2; para. [0020]) having an inner perimeter (item 23; Figs 1, 2; para. [0020]) and an exterior perimeter (item 25; Figs. 1,2; para. [0020]), and having a first surface and a second surface on an opposite side from the first surface. A seal bead (item 24; Figs. 1,2; para. [0020]) rising from the first surface a first predetermined height, and being generally adjacent to and extending about the inner perimeter (23). The seal bead (24) being made from an elastomeric material. A fastener hole (item 30; Figs. 1, 2; para. [0021]) extending through the first portion from the first surface to the second surface and located between the seal bead (24) and the exterior perimeter (25). A protruding feature (item 32; Figs. 1, 2; para. [0021]) made from the elastomeric material and located between the fastener hole (30) and the exterior perimeter (25) and spaced from the seal bead (24), and rising from the first surface a second predetermined height that is about equal to or greater than the first predetermined height. The protruding feature (32) having first and second terminating end portions (items 32a, 32b; Fig. 2; para. [0021]) so as not to circumscribe the fastener hole (30). As illustrated in Fig. 8, the protruding feature (32, 96) prevents a flange (97), sealing against a sealing bead (94) via torque from a bolt (98), from bending in such a way as to weaken the seal due to the flange bending and prevents the flange from cracking (See paras. [0008], [0009]).

VI. GROUNDS OF OBJECTION TO BE REVIEWED ON APPEAL

A. Whether Ueta (U.S. Pat. No. 5951021) anticipates Claims 1-4, 6-7, and 9-10 under 35 U.S.C. § 102(b).

B. Whether the combination of Ueta (U.S. Pat. No. 5951021) and Yoshida et al (U.S. Pat. No. 5938208) establish a prima facie case of obviousness under 35 U.S.C. § 103(a), with respect to Claim 5.

C. Whether the combination of Ueta (U.S. Pat. No. 5951021) and Incoing (U.S. Pat. No. 4625979) establish a prima facie case of obviousness under 35 U.S.C. § 103(a), with respect to Claim 8.

VII. ARGUMENT

A. UETA (U.S. PAT. NO. 5951021) DOES NOT ANTICIPATE THE INVENTION OF CLAIMS 1-4, 6-7, AND 9-10

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Vendegaal Bros., Inc. v. Union Oil Co.*, 814 F. 2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987) (citing *Structural Rubber Prods. Co. v. Park Rubber Co.*, 749 F.2d 707, 715 223 USPQ 1264, 1270 (Fed. Cir. 1984); *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 1548, 220 USPQ 193, 198 (Fed. Cir. 1983); *Kalman v. Kimberly-Clark Corp.*, 713 F. 2d 760, 771, 216 USPQ 781, 789 (Fed. Cir. 1983)). "[A]bsence from the reference of any claimed element negates anticipation." *Kloster Speedsteel AB v. Crucible, Inc.*, 793 F.2d 1565, 1571, 230 USPQ 81, 84 (Fed. Cir. 1986).

Applicant notes that claim 1 includes the limitation of "a protruding feature made from said first material and located between the fastener hole and the exterior perimeter and spaced from said seal bead, and rising from the first surface a second predetermined height that is about equal to or greater than the first predetermined height, said protruding feature having first and second terminating end portions so as not to circumscribe said fastener hole." Similarly, claim 10 includes the limitation of "forming a protruding feature made from said first material between the fastener hole and the exterior perimeter and spaced from said seal bead, and rising from the first surface a second predetermined height that is about equal to or greater than the first predetermined height, said protruding feature having first and second terminating end portions so as not to circumscribe said fastener hole." The protruding feature (32) is described in detail above in Section V. above.

Contrary to this, Ueta '021 discloses rubber beads 24 "formed around each bolt hole" (see col. 14, lines 44-45). More specifically, the specification of Ueta '021 discloses "beads 24, 24' are also formed to bound each of the cylinder bore holes 13, bolt holes 14, oil holes 15 and water holes 16" (see col. 14, lines 46-48). The specification further states "as shown in FIGS. 3 to 4, the rubber bead 24 formed, in particular, around the bolt hole 14 has a cross section..." (see col. 14, lines 50-52). Accordingly, it is clear from the specification of Ueta '021 that every bolt hole 14 is

bound (or circumscribed) by a bead 24 that does not include first and second terminating end portions, as claimed.

The Examiner asserts that "Ueta discloses a protruding feature (protruding feature 24 that is between two adjacent bolt holes) that is spaced from the seal bead and which has the first and second terminating end portions so as not to circumscribe the fastener hole" (See Office Action dated April 14, 2005). However, Applicant respectfully submits that the bead sections 24 extending between two adjacent bolt holes of Ueta '021 are not "located between the fastener hole and the exterior perimeter" as required by claim 1. Therefore, the bead sections 24 extending between two adjacent bolt holes, as asserted by the Examiner, does not anticipate the "protruding feature", as claimed. Accordingly, claims 1 and 10 are not properly anticipated by Ueta '021. Claims 2-4, 6, 7 and 9 depend from claim 1 and should be allowable for the same reasons as claim 1 as discussed above.

B. THE COMBINATION OF UETA (U.S. PAT. NO. 5951021) AND YOSHIDA ET AL (U.S. PAT. NO. 5938208) DO NOT RENDER OBVIOUS THE INVENTION OF CLAIM 5

Claim 5 is dependent upon claim 1 and should be allowable for the same reasons as claim as discussed above.

C. THE COMBINATION OF UETA (U.S. PAT. NO. 5951021) AND INCOING (U.S. PAT. NO. 4625979) DO NOT RENDER OBVIOUS THE INVENTION OF CLAIM 8

Claim 8 is dependent upon claim 1 and should be allowable for the same reasons as claim as discussed above.

In view of the above arguments, applicants request that this Board overturn the rejections of claims 1-10.

VIII. CLAIMS

A copy of the claims involved in the present appeal is attached hereto as Appendix A. As indicated above, the claims in Appendix A include the amendments filed by Applicant on February 8, 2005.

IX. EVIDENCE

No evidence pursuant to §§ 1.130, 1.131, or 1.132 or entered by or relied upon by the examiner is being submitted.

X. RELATED PROCEEDINGS

No related proceedings are referenced in II. above, or copies of decisions in related proceedings are not provided, hence no Appendix is included.

Dated: November 11, 2005

Respectfully submitted,

By

Ronald W. Wangerow

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FREUDENBERG-NOK GENERAL PARTNERSHIP

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APPENDIX A**Claims Involved in the Appeal of Application Serial No. 10/790916**

1. A gasket comprising:

a first generally planar portion having an inner perimeter and an exterior perimeter, and having a first surface and a second surface on an opposite side from the first surface;

a seal bead rising from the first surface a first predetermined height, and being generally adjacent to and extending about the inner perimeter, said seal bead being made from a first material;

a fastener hole extending through the first portion from the first surface to the second surface and located between the seal bead and the exterior perimeter; and

a protruding feature made from said first material and located between the fastener hole and the exterior perimeter and spaced from said seal bead, and rising from the first surface a second predetermined height that is about equal to or greater than the first predetermined height, said protruding feature having first and second terminating end portions so as not to circumscribe said fastener hole.

2. The gasket of claim 1 further including a second seal bead rising from the second surface a third predetermined height, and being adjacent to and extending about the inner perimeter; and a second protruding feature located between the fastener hole and the exterior perimeter, and rising from the second surface a fourth predetermined height that is about equal to or greater than the third predetermined height.

3. The gasket of claim 2 wherein the gasket is adapted to seal between separator plates in an individual cell of a fuel cell assembly.

4. The gasket of claim 2 wherein the gasket is adapted to seal between a thermostat and a mating member in a cooling system of an engine.

5. The gasket of claim 1 wherein the first generally planar portion is a carrier made of a polymeric material and the seal bead is made of an elastomeric material.

6. The gasket of claim 5 wherein the seal bead is molded to the carrier after the carrier is formed.

7. The gasket of claim 1 wherein the first generally planar portion and the seal bead are molded integrally from an elastomeric material.

8. The gasket of claim 1 further including a second seal bead rising from the first surface the first predetermined height, and being adjacent to and extending about the seal bead.

9. The gasket of claim 1 further including a second fastener hole extending through the first portion from the first surface to the second surface, spaced from the fastener hole, and located between the seal bead and the exterior perimeter; and a second protruding feature located between the second fastener hole and the exterior perimeter, and rising from the first surface the second predetermined height.

10. A method of making a gasket comprising the steps of:

forming a first generally planar portion having an inner perimeter and an exterior perimeter, and having a first surface and a second surface on an opposite side from the first surface;

forming a seal bead so that the seal bead rises from the first surface a first predetermined height, and is generally adjacent to and extending about the inner perimeter, said seal bead being made from a first material;

creating a fastener hole extending through the first portion from the first surface to the second surface and located between the seal bead and the exterior perimeter; and

forming a protruding feature made from said first material between the fastener hole and the exterior perimeter and spaced from said seal bead, and rising from the first surface a second predetermined height that is about equal to or greater than the first predetermined height, said protruding feature having first and second terminating end portions so as not to circumscribe said fastener hole.



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Invention: Seal Feature To Prevent Bending			

TO THE COMMISSIONER OF PATENTS:

Transmitted herewith is the Appeal Brief in this application, with respect to the Notice of Appeal filed: September 14, 2005.

The fee for filing this Appeal Brief is \$ 500.00.

Large Entity Small Entity

A petition for extension of time is also enclosed.

The fee for the extension of time is _____.

A check in the amount of _____ is enclosed.

Charge the amount of the fee to Deposit Account No. _____.
This sheet is submitted in duplicate.

Payment by credit card. Form PTO-2038 is attached.

The Director is hereby authorized to charge any additional fees that may be required or credit any overpayment to Deposit Account No. _____.
This sheet is submitted in duplicate.

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